

REMARKS

Claims 1-8 and 10 have been examined. With this amendment, claims 11-14 have been added. Claims 1-8 and 10-14 are all the claims pending in the application.

I. Claim Rejections - 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-8 and 10 under 35 U.S.C. 103(a) as being unpatentable over Hou *et al.* (US 5,325,421) [“Hou”] in view of Barber *et al.* (US 5,251,251) [“Barber”]. For at least the following reasons, Applicant traverses the rejection.

Claim 1 recites a telecommunication system wherein “at least one message being associated with a specific signal generated by said first terminal” is sent to a memory and “wherein in response to detecting said specific signal, said processor of said switch automatically orders said memory to generate and send said at least one message to said second terminal.” The Examiner concedes that Hou does not disclose this feature, but applies Barber to allegedly cure the deficiency.

Hou discloses a system that allows a user to know the status of voice messages (from no voice messages to the number of voice messages) without having the user call the voice messaging service himself (see col. 12, lines 33-40). Hou discloses that when a user places an outgoing call, the CIU will call the voice messaging service 300 to check whether there are any messages for the subscriber’s telephone number (col. 12, lines 49-62). This solves the problem of a user not knowing if he has messages until he calls the voice messaging system (see col. 12, lines 33-35).

Barber discloses a system of distributing “greeting cards” by using pre-recorded voice messages of celebrities (Abstract). Barber discloses that a subscriber to the system will store a message by providing an access code (col. 4, lines 22-25). The subscriber then mails the access code to the recipient, who then retrieves the message using the access code.

The Examiner contends that one skilled in the art would have been motivated to combine the references “so that the recipient would receive a special greeting associated with a code.” Applicant submits that the Examiner’s proffered motivation to combine is clearly not supported by the prior art.

To modify the invention in Hou to receive “special greetings associated with a code,” the user must first send out the special code. Accordingly, the primary principle of operation for the invention in Hou is changed. That is, the user no longer gets a status of his messages by just making a general outgoing call, but must now dial the voice messaging service directly in order to receive the “special message.”

Although Hou contemplates the direct dial of the voice messaging service to retrieve messages, there is no disclosure or suggestion in Hou that a “special message,” which requires an access code is useful in its underlying concept of getting a status of the voice messages for a user. Similarly, there is no disclosure or suggestion in Barber that its unique method of distributing one-time “greeting cards” would be a useful addition to a normal voice messaging service or to help in determining the status of voice messages for a user. In fact, Barber teaches the use of mail to notify the recipient that he has a “special message.”

Therefore, Applicant submits that, other than the fact that voice messages are stored, the underlying concepts, problems that were solved and the purpose of the inventions in the teachings of Hou and Barber are unrelated. Accordingly, one skilled in the art would not have combined the inventions.

“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP at 2100-131. Here, there is clearly no motivation to combine the references since Hou merely contemplates getting a status of voice messages and Barber merely contemplates sending “special messages.” Accordingly, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness.

II. New Claims

With this amendment, Applicant adds claims 11-14. Applicant submits that these claims are patentable at least by virtue of their respective dependencies, as well as the features set forth therein.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment Under 37 C.F.R. § 1.111
U.S. Serial No. 09/840,045

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